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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/817,054

04/02/2004

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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT

PAPER NUMBER

2134

MAIL DATE

DELIVERY MODE

09/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/817,054	Applicant(s) MOROHASHI ET AL.	
	Examiner Matthew Heneghan	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-16 have been examined.

Priority

2. The instant application claims priority to Japanese Patent Application No. 2003-343480, filed 1 October 2003.

Information Disclosure Statement

3. The following Information Disclosure Statement in the instant application has been fully considered:

IDS filed 2 April 2004.

Specification

4. The abstract of the disclosure is objected to because it includes reference numbers for some items. Correction is required. See MPEP § 608.01(b).

Claim Objections

5. Claims 15 and 16 are objected to because of the following informalities: Each claim lacks a transitional phrase that immediately precedes the recited method steps. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 10, the claims recites several method steps for using the system on p. 41, lines 6-18 and all of claim 11, rendering the claims indefinite.

For purposes of the prior art search, the limitations on p. 41, lines 6-18 are being deemed inherent. Claim 11 stands or falls with base claim 10.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7, 9, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0006704 to Dahlstrom et al.

As per claims 1 and 15, Dahlstrom discloses a set of databases that may be deployed among several networked computers capable of transmitting data as necessary, the first through third information processing apparatuses (see paragraphs 34-35), having a treated threat storage section, the security vulnerability database (see paragraphs 24-25), as threat data storage section, product tracking information (see paragraph 42), with data from each table being used to determine correspondence data, tracking information (see paragraph 31) and an extraction section for describing the evaluated data (see paragraph 71 and 72).

As per claim 2, there is a list of unresolved security vulnerabilities (see paragraph 31).

As per claims 3, 4, and 16, vulnerabilities based upon impact ratings are compiled and displayed in descending order (high, then medium, then low) (see paragraphs 65-72 and figure 10), with lists of both pending (untreated) and completed (treated) vulnerabilities (see items 1012 and 1014).

Regarding claim 5, the impact (risk rating) of a threat is stored on a per-threat basis; therefore, it is sent to the first database with the threat information (see paragraph 42).

As per claim 6, the updating of appropriate fields is supported (see paragraph 46).

As per claim 7, the report may be displayed (see paragraphs 70-72).

Regarding claim 9, the limitations of the claim only teach to the roles of the various users of the claimed system, and not to the structure of the system itself. Since the claimed system is capable of being used by anyone, including customers, threat information providers, and evaluators, the additional limitations of claim 9 over base claim 1 are inherent.

As per claims 13 and 14, comparisons are made between the second and third databases to create appropriate evaluation data (see paragraph 46).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0006704 to Dahlstrom et al. as applied to claim 1 et al. above, and further in view of U.S. Patent Application Publication No. 2002/0040306 to Sugiyama et al.

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Regarding claims 8 and 12, Dahlstrom does not disclose an additional site for insurance considerations.

Sugiyama discloses an analogous network risk management system in which there is a database either at the user site or at an insurance site for correlating and entering insurance coverage information in conjunction with other databases (see paragraphs 39 and 40).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to implement Dahlstrom's system that establishes computer security risks into Sugiyama's system.

Regarding claims 10 and 11, the limitations of the claim only teach to the roles of the various users of the claimed system or to steps for using the system, and not to the structure of the system itself. Since the claimed system is capable of being used by anyone, including customers, threat information providers, and evaluators, the additional limitations of claims 10 and 11 over base claim 8 are inherent.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is

(571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand, can be reached at (571) 272-3811.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Matthew Heneghan/

September 6, 2007

Patent Examiner (FSA), USPTO Art Unit 2134